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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,973	05/30/2001	Ronald Paul Rohrbach	H0001202	8302
7590 06/16/2004				
Honeywell International Inc. 101 Columbia Road P.O. Box 2245 Morristown, NJ 07962		EXAMINER CINTINS, IVARS C		
		ART UNIT 1724		

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary**Application No.**

09/867,973

Applicant(s)

ROHRBACH ET AL.

Examiner

Ivars C. Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by DeJovine (U.S. Patent No. 4,144,166). As pointed out in the previous Office action, DeJovine discloses an oil filter comprising a hollow housing 6 having an inlet 8 and an outlet 10, a mechanically active filter member 4 disposed inside the housing, and a chemically active filter member 2 disposed inside this housing. The chemically active filter member 2 includes a plurality of particles, which particles can include a beneficial additive such as antioxidant of the type recited (see col. 11, lines 48-51), or a combination of this antioxidant with a basic salt of the type recited (see col. 11, lines 57-58). Applicant should note that since claim 1 merely recites that the particles in the chemically active filter member comprise a beneficial additive (see line 9), this claim is not deemed to exclude the other solid particles (e.g. graphite) employed by DeJovine.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is again rejected under 35 U.S.C. 103(a) as being unpatentable over DeJovine in view of Bilski et al. (U.S. Patent No. 5,725,031). As pointed out in the previous Office action, DeJovine discloses the claimed invention with the exception of the location of the chemically

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active filter element with respect to the mechanically active filter element. Bilski et al. discloses a similar oil filter containing both a mechanically active filter element and means for adding an anti-wear chemical to oil undergoing treatment, and further discloses (see Fig. 1) locating the chemical adding element radially and coaxially inside the mechanically active filter element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the chemically active filter element (i.e. 2) of the DeJovine device inside the mechanically active filter element (i.e. 4), as suggested by Bilski et al, in order to produce a more compact filtration and treatment device.

Claims 7-10 and 13-16 are again rejected under 35 U.S.C. 103(a) as being unpatentable over DeJovine in view of Brownawell (U.S. Patent No. 5,225,081). As pointed out in the previous Office action, DeJovine discloses the claimed invention with the exception of the construction of the filter housing and/or supplemental cartridge, and the size of the particles in the chemically active filter element. Brownawell discloses an oil filter having both a mechanically active filter member and a chemically active filter member, and further shows a filter housing and supplemental cartridge having the recited construction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the filter housing of DeJovine in the manner suggested by Brownawell, in order to provide a device with easily replaceable components. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ particles having the recited size in the system of DeJovine, since this primary reference clearly teaches (see col. 2, lines 57-60) that the size of the particles employed is not critical and may vary over a wide range.

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Applicant's arguments filed April 5, 2004 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that DeJovine does not anticipate the claimed invention which requires that the beneficial additive consist essentially of an antioxidant or a mixture of a basic salt and an antioxidant. It is pointed out, however, that the antioxidant compounds of DeJovine (col. 11, lines 48-51) clearly consist essentially of an antioxidant, and when these antioxidant compounds are used in combination with only a basic salt (col. 11, lines 57-58), this mixture also consists essentially of antioxidant and a basic salt. Since the particles recited in the chemically active filter are not limited to only beneficial additives, i.e. by virtue of the "comprising" language in the claims (see claim 1, line 9; claim 7, line 18; and claim 13, line 17), they may include other additives, so long as these other additives are not designated by the term "beneficial." Accordingly, claims 1-10 and 13-17 are deemed to only require the presence of relatively pure antioxidant additive or relatively pure antioxidant-basic salt additive, and are not deemed to exclude the presence of other additive materials.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

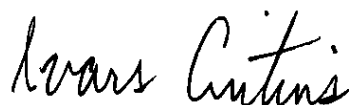
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (571) 272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Blaine Copenheaver, can be reached at (571) 272-1156.

The centralized facsimile number for the USPTO is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
June 13, 2004